

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 18-20 and 25-27, drawn to a multilayer plastic molding;
- Group II: Claims 21-24, drawn to a plastic molding made with a specific polymer composition;
- Group III: Claim 28, drawn to a process for making a plastic molding;
- Group IV: Claims 29 and 31, drawn to a third type of plastic molding;
- Group V: Claim 30, drawn to a fourth type of plastic molding; and
- Group VI: Claim 32, drawn to a process for making a plastic molding different from the plastic molding made in Group III.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that Groups I-VI do not relate to a single general inventive concept because they lack of the same or corresponding special technical features. However, Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the international application and examined all claims together (see the International Preliminary Examination Report appended herewith).

Applicants note that PCT Article 27(1) states that no national laws shall require compliance

with requirements relating to the form and content of the international application different from or additional to those which are provided for in the Patent Cooperation Treaty and the regulations.

In fact, Applicants point to Section V of the International Preliminary Examination Report, in which the International Authority found the present invention to possess novelty.

Furthermore, the Office has simply proposed special technical features for the various groups and has concluded that they are different, without providing reasons therefore.

Applicants respectfully submit that these conclusory statements by the Examiner do not adequately support any conclusion with regard to patentable distinctness.

Moreover, M.P.E.P. § 803 states:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order sustain the requirement for restriction.

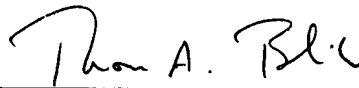
Applicants therefore request that the requirement for restriction be withdrawn.

Application No. 10/019,025
Reply to Office Action of July 29, 2003

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference NAE19990345P	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP00/05755	International filing date (day/month/year) 21 June 2000 (21.06.00)	Priority date (day/month/year) 23 June 1999 (23.06.99)
International Patent Classification (IPC) or national classification and IPC B29C 45/14		
Applicant BASF AKTIENGESELLSCHAFT		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of <u>6</u> sheets, including this cover sheet. <input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT). These annexes consist of a total of <u>5</u> sheets.
3. This report contains indications relating to the following items: I <input checked="" type="checkbox"/> Basis of the report II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application

Date of submission of the demand 23 January 2001 (23.01.01)	Date of completion of this report 27 September 2001 (27.09.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP00/05755

I. Basis of the report

1. With regard to the elements of the international application:*

- ☐ the international application as originally filed
- ☒ the description:
pages _____ 1-23 _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____
- ☒ the claims:
pages _____, as originally filed
pages _____, as amended (together with any statement under Article 19
pages _____, filed with the demand
pages _____ 1-12//13-17 _____, filed with the letter of _____ (28.08.01//04.09.01)
- ☐ the drawings:
pages _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
pages _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

5. ☒ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

I. Basis of the report

1. This report has been drawn on the basis of *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.)*:

...

5. ...

1. The application does not meet the requirements of PCT Article 34(2)(b) since the subject matter of Claims 13 to 17 goes beyond the disclosure in the application as filed.

2. The combination of features in Claim 13 was not disclosed by the version of the application originally filed.

3. The combination of features in Claim 14 was not disclosed by the version of the application originally filed.

4. Claims 15 to 17 refer to Claim 13 and/or Claim 14. Therefore the same objection as in paragraphs 2 and 3 applies to these claims.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/EP 00/05755

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1 - 12	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1 - 12	NO
Industrial applicability (IA)	Claims	1 - 12	YES
	Claims		NO

2. Citations and explanations

1. Reference is made to the following document:

D1 = DE-A-196 51 350.

2. The application does not meet the requirements of PCT Article 33(3) since Claim 1 does not involve an inventive step.

2.1 D1 describes a back injection moulded plastics part consisting of a plastics back injection foil (cf. page 8, lines 35 to 37) which is back injected with a reinforced plastics material containing between 5 and 30 wt % fibres (component (1) as per Claim 1).

The subject matter of Claim 1 differs from D1 in that it states that the thickness of the back injection material ranges from 1.5 to 4.5 mm and the length of at least some of the fibres is more than 1 mm.

The object achieved by these additional features is to produce an alternative back injection moulded part.

The choice of thickness of the back injection material and the length of the fibres appears to be obvious to a person

skilled in the art since it is selected from a limited number of possibilities by means of routine tests (cf. PCT/GL/IPE Chapter IV-8.8(C1)(ii)).

Moreover, no evidence of a technical effect of these additional features over D1 is provided.

The applicant substantiates the inventive step of the subject matter of Claim 1 with a number of advantages of the claimed moulded bodies with respect to those in which a non-reinforced ABS substrate layer is used.

However, such grounds are unacceptable since the moulded bodies described in D1 have the same advantages (cf. D1, page 8, lines 45 to 68).

2.2 The alternative in which up to 50 wt % of the fibres are replaced by mineral fillers is also disclosed in D1 (cf. D1, component D). Therefore this alternative does not appear to be inventive either.

3. The subject matter of Claims 2 and 3 cannot be considered inventive either since the claimed ranges of figures of the foil thickness overlap with those described in D1 (cf. page 7, lines 34 to 36).

4. The additional features in Claim 4 are disclosed in D1:
the components A, B and C (optional) of the substrate layer are described using the same designations in Claim 1;
the (optional) intermediate layer of impact-resistant polymethylmethacrylate or polycarbonate is mentioned in Claim 2; the examples (cf. page 9, lines 3 and 4) indicate that the intermediate layer is 0.25 mm thick;

the transparent cover layer of polymethylmethacrylate is disclosed in Claim 3; the cover layer used in the examples is 0.05 mm thick (cf. page 9, lines 4 and 5).

The alternative ABS substrate layer is also known from the prior art (cf. page 2, lines 4 and 5, of the description). The other polymers mentioned in Claim 4 (page 25, lines 25 to 27) do not appear to have any special technical effect as a substrate layer.

Therefore dependent Claim 4 also does not appear to involve an inventive step.

5. The additional features of Claims 5 and 6 are known from D1 (cf. page 7, lines 34 to 42) or are conventional technical measures. Therefore Claims 5 and 6 cannot be considered inventive.

6. The additional features in Claims 7 to 9 are disclosed in D1 (cf. page 8, lines 36 and 37; Claim 2; page 7, lines 24 and 25; Claim 2).

Although they are not known from D1, the features in Claim 10 do not appear to have any special technical effect and therefore Claims 7 to 10 cannot be considered inventive.

7. D1 also discloses a method of producing back injection moulded plastics parts according to the concept of the application by producing the back injection foil by adapter or nozzle coextrusion (thus in a one-stage process), thermoforming the back injection foil and back injecting the foil with the fibre-reinforced plastics material (cf. Claims 6, 9 and 10).

The method according to Claim 11 differs from D1 in that the fibres are added directly in metered manner whilst the plastics material is being processed in order that at least some of the fibres in the formed product are longer than 1 mm. However, a differentiating feature of this type appears to be a conventional technical measure.

Therefore the subject matter of Claim 11 does not appear to involve an inventive step.

8. The use of back injection moulded plastic parts of the type according to the application as motor vehicle bodywork outer parts is described in D1 (cf. page 8, lines 14 and 15). Therefore the subject matter of Claim 12 cannot be considered inventive.